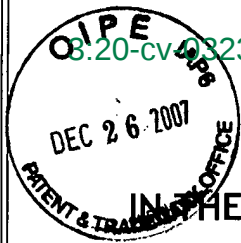


EXHIBIT 7



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	≡	Docket No.:1377.162:C7a
Christopher HARDY et al.	≡	Art Unit: 2914
Serial No. 29/267,535	≡	Filed: October 17, 2006
For: PORTION OF A MESH BASKET	≡	Examiner: Eric L. Goodman

PRELIMINARY AMENDMENT

Mail Stop AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir or Madam:

Favorable consideration of this application in view of the following remarks is respectfully requested. Applicants respectfully submit these Remarks, Inventor's Declaration, and a petition for a three month extension of time in response to the Office Action dated June 25, 2007.

REMARKS

The Examiner has objected to certain language in the Inventors' Declaration. A new Declaration reflecting the language sought by the Examiner is submitted herewith.

As per the Examiner's comment, the appendix will be cancelled upon indication of allowable subject matter.

CLAIM REJECTION - 35 U.S.C. § 103

The claim stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the elfa® Medium 3-Runner Drawer (hereinafter "elfa") depicted in the 1999 and 2001 catalogs of The Container Store® in view of the Design Ideas 2300 Mesh ShopCrate (hereinafter "ShopCrate") depicted in the 1995 Design Ideas catalog. This rejection is respectfully traversed.

I. elfa® is not a Proper Rosen Reference

The Federal Circuit has held that a properly conducted patent analysis, be it for infringement or validity, necessarily requires construing the claimed design. *Berry Sterling Corp. v. Pescor Plastics, Inc.*, 43 USPQ2d 1953 (Fed. Cir. 1997).

In *Durling v. Spectrum Furniture*, 40 USPQ2d 1788 (Fed. Cir. 1996), the district court invalidated a design patent on the grounds of obviousness. On appeal to the Federal Circuit, the patentee contended that the district court's invalidity decision was erroneous because no primary *Rosen* reference exists. *Id.* at 1790.

The Federal Circuit explained that the first step in an obviousness analysis for a claimed design requires a search of the prior art for a primary reference, citing *In re Rosen*, 673 F.2d 388, 213 USPQ 347 (CCPA 1982). This requires, the Court said, for one to first discern the correct visual impression created by the claimed design as a whole, and second to determine whether there is a single reference that creates "basically the same" visual impression. *In re Rosen*, 673 F.2d at 391, 213 USPQ at 350.

In *Durling*, the Federal Circuit criticized the district court's claim construction of the claimed design, saying that the district court's description did not evoke a visual image consonant with the claimed design. The Federal Circuit found that the district court "construed [the patentee's] claimed design too broadly," *Durling*, 40 USPQ2d at 1791, focusing on the general concept rather than its visual appearance. The Court proceeded to construe the claim much more specifically than the district court, and then found that the main prior art or *Rosen* reference "does not create the same visual impression as does [the] claimed design," *Id.*, and thus "cannot suffice as a primary reference," *Id.*, and thereby reversed the district court's holding of obviousness.

The Court concluded:

The record contains no prior art design that creates basically the same visual impression as does [the] claimed design. No primary reference has been shown to exist. Without such a primary reference, it is improper to invalidate a design patent on grounds of obviousness.

Id.

Therefore, the first step in this obviousness inquiry requires us to construe the claimed design. Applicants submit that the claimed design as a whole, with reference to the Figure of the claim (and, supplementally, a photograph of an article embodying the claimed design, provided as Exhibit 1) is properly construed as follows:

A portion of mesh drawer, comprising:

- (a) a drawer that includes four sidewalls;
- (b) each of the sidewalls being angled upwardly and outwardly from the bottom portions thereof;
- (c) the sidewalls each being formed of a fine, expanded metal mesh;
- (d) the fine, expanded metal mesh having very small, generally diamond-shaped openings that present a veil-like appearance;
- (e) the mesh sidewalls joined to adjacent mesh sidewalls by a closed corner;
- (f) the closed corners being generally curved;
- (g) the closed corners being made of a fine, expanded metal mesh;
- (h) the closed corners being formed seamlessly with adjacent sidewalls;

and

(i) a flat upper rim extending peripherally about the top edges of the mesh sidewalls.

The foregoing claim construction, comprising 9 design elements, evokes a visual image consonant with the claimed design as a whole, thus fulfilling the first step of the obviousness analysis required by the Federal Circuit. *Durling*, 40 USPQ2d at 1790.

The second step is to determine whether there is a single reference that creates “basically the same” visual impression as the construed claim. *Id.* The PTO asserts that the elfa® Medium 3-Runner Drawer (depicted in The Container Store® catalogs and further shown in the photograph provided as Exhibit 2) is that basic reference. Applicants respectfully disagree.

In fact, there are significant differences between the properly construed claim of the present design and the elfa® drawers of The Container Store® prior art. The elfa reference is conspicuously missing fully two-thirds (i.e., 6 of 9) of the design elements that form the claim construction: elements (c), (d), (e), (f), (g), and (h). It is clear, simply from the weight of this evidence, that the elfa® reference is not “basically the same” as the claimed design. What follows is an element-by-element comparison of elements (c), (d), (e), (f), (g), and (h) of the properly construed claim of the claimed design with the prior art:

(c) *the sidewalls each being formed of a fine, expanded metal mesh*
 - The sidewalls of elfa® are formed of widely spaced, round, horizontally and vertically disposed wires that criss-cross at 90 degree angles to form a Cartesian grid. As can perhaps be more clearly seen from the photograph of the entire elfa drawer shown in Exhibit 2, its side panels are composed of large squares, perhaps 100 per wall. By contrast, the claimed design has thousands of openings on each

of its side panels, and creates the visual impression of a veil in contrast to the generally open structure of elfa. (In fact, the elfa openings are more than wide enough for the average person contemplating the appearance of the elfa drawer to think that he could easily insert several of his fingers into them - which he could. Clearly this does not create basically the same visual impression on the observer as the design set forth in the claim.)

(d) the fine, expanded metal mesh having very small, generally diamond-shaped openings - The openings between the criss-crossed wires of elfa® are not only very large and square; they are oriented to encourage the eye of the observer to focus on individual openings from across a room and follow their bounding wires along their orthogonal Cartesian horizontal and vertical directions. The mesh employed in the claim does not run along such orthogonal or vertical and horizontal directions, but has a much, much finer diagonal grid pattern, which creates a very different visual impression on the observer.

(e) the mesh sidewalls joined to adjacent mesh sidewalls by a closed corner - consonant with and supportive of the open design provided by its large, open grid pattern, the elfa® wire drawers also have open corners that define gaps large enough to accommodate an entire adult human hand. This feature reinforces the general visual impression of openness characteristic of the elfa drawers.

(f) the closed corners being generally curved - since the corners of elfa® are open, there can be no curved corners (even, assuming *arguendo*, the corners of elfa® were closed, it is not seen how the individual wires of elfa® could form a curved corner).

(g) the closed corners being made of a fine, expanded metal mesh - the corners of elfa® are open, and there is no suggestion of metal mesh.

(h) the closed corners being formed seamlessly with adjacent sidewalls - the corners of elfa® are open (even if elfa's corners were, *arguendo*, closed, it is not apparent how they would be formed seamlessly, since every wire of elfa® by definition creates a seam)

In view of these significant differences, just as in *Durling, supra*, it cannot be said that the elfa® drawers in The Container Store® prior art create basically the same visual impression as does the claimed design. Among other things, the elfa drawers are open in appearance to the point of inviting users to enter their

interior from the sides and through their corners, both through the relative scale of the spacing between their rectilinear grid wires and through the use of open corners, whereas the claimed design uses a fine mesh and closed corners that suggests the more closed appearance of a veil. Also, the orientation and scale of the wires of elfa invite the user to focus on the individual wire elements of the drawer and then run one's eyes horizontally or vertically along their length - a visual impression that the claimed design certainly does not provide. Hence, The Container Store® elfa prior art is not properly a *Rosen* reference. Therefore, the §103 rejection in this case has no base on which to stand, for the very reason it could not stand in *Durling, supra*.

II. The 2003 Mesh Shop Crate Fails to Cure the Deficiencies of elfa®

As noted above, elfa is not a valid *Rosen* reference, and there are differences between elfa and the claim which the Examiner has simply not addressed, such as the open corners of elfa versus the closed, smoothly rounded corners of the instant claim. After misconstruing the proximity of elfa to the claim, the Examiner then turns to ShopCrate to provide the one thing that he acknowledges elfa lacks: a fine diamond mesh.

The elfa Drawer has an overall appearance basically the same as the claimed design the only difference being the lack of a fine diamond mesh.

The 2300 Mesh ShopCrate teaches a fine diamond mesh.

It would have been obvious to a designer of ordinary skill in the art at the time the invention was made to modify the elfa Drawer to have a fine diamond mesh as

taught by the Mesh ShopCrate, resulting in an overall appearance substantially the same as that claimed and over which the claimed design bears no unobvious ornamental differences.

(Office Action, dated June 25, 2007, page 3)

The Examiner believes that this modification of the basic reference in light of the secondary prior art is proper because the applied references are so related that the appearance of features shown in one would suggest the application of those features to the other. (Office Action, June 25, 2007, page 3 citing *In re Rosen*, 673 F.2d 388, 213 USPQ 347 (CCPA 1982); *In re Carter*, 673 F.2d 1378, 213 USPQ 625 (CCPA 1982), and *In re Glavas*, 230 F.2d 447, 109 USPQ 50 (CCPA 1956)). The Examiner further notes that one skilled in the art is charged with knowledge of the related art, such that “the combination of old elements, herein, would have been well within the level of ordinary skill.” *Id.* (citing *In re Antle*, 444 F.2d 1168, 170 USPQ 285 (CCPA 1961) and *In re Nalbandian*, 661 F.2d 1214, 211 USPQ 782 (CCPA 1982)).

The Examiner seeks to use ShopCrate to show the mesh admittedly lacking in elfa®. The Examiner’s rejection thus embodies the following logic: it would have been obvious to replace the wire grid of elfa® with the mesh of ShopCrate, thus creating the claimed design.

ShopCrate (a photograph of the product is provided as Exhibit 3) teaches a mesh density far less than half of that of the claimed fine mesh. It simply does not evoke the visual impression of a veil of tight metal mesh that the claimed design creates. Thus, even if one were to modify elfa® by substituting the large

mesh pattern of ShopCrate for the open gridwork of elfa®, the resulting design still would not provide basically the same visual impression of a veil that is provided by Applicants' claimed design.

Moreover, absent the legally impermissible goal of recreating the claimed design from visually discordant pieces of the prior art, why stop there? ShopCrate employs rounded corners having substantially greater radii of curvature than those in the claimed design, and ShopCrate has a trapezoidal form in profile that is much more pronounced than either elfa® or the claimed design. Absent the present claimed design as a guide, who can say what one would end up with, except that it still would not look like the claimed design?

The U.S. Court of Appeals for the Federal Circuit has specifically rejected similar such logic, which is premised upon a combination of known elements from the prior art.

More particularly, the case law from the Federal Circuit makes it clear that *the ornamental quality of the combination of elements* must be suggested in the prior art (emphasis added). *In re Rosen, supra*. A reconstruction of known elements does not render a claimed design obvious, absent some basis whereby a designer of ordinary skill would be led to create the particular design. *L.A. Gear Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1124, 25 USPQ2d 1913, 1918 (Fed. Cir. 1993).

To be specific, there is no suggestion that the elfa® open corner configuration be closed. Indeed, the open character of the elfa corners is visually consonant with and supportive of its use of open, large openings in its sides, which are far removed from mesh in visual appearance. These two aspects of elfa are

thus to be seen as twinned to one another: the open corners and spacious openings both combine to lend the elfa basket a particularly airy feel that necessarily changes once either the corners are closed or a mesh is used in its place.

There is no teaching or suggestion in the prior art for applying the gridwork of ShopCrate to the elfa® drawers. It simply is not the law that all designs of mesh drawers would have been obvious because mesh is known in the prior art and drawers without mesh of various dimensions are known in the prior art. Thus, under the controlling case law, Applicants' claimed design cannot be held to have been obvious.

Additionally, since the prior art is devoid of a *Rosen* reference teaching a mesh basket of the nature claimed (taking into account the deficiencies of elfa® noted above), there cannot be any motivation to combine the mesh of ShopCrate to a non-existent basket.

III. The Examiner is Improperly Relying on Obviousness of Construction

This is a rather classic example of the Examiner improperly relying upon obviousness of construction, more appropriate to a utility patent (see *Rosen, supra* and *In re Cho*, 813 F.2d 378, 1 USPQ 2d 1662 (Fed. Cir. 1987)). In other words, Applicants' design is the first to use and claim the combination of a fine, tight metal mesh basket having slightly tapering sidewalls, closed corners, and a flat rim, among other features. This combination creates a distinctly different overall appearance from the elfa® and the ShopCrate prior art. The primary

reference relied upon by the Examiner has large open lattice wires that create a completely different, wide open overall appearance when compared to the claimed design. The case law is clear: *just because it may have been obvious from a utility standpoint to change the material and corners of the elfa® basket to have mesh and closed corners does not mean that the overall appearance embodied by the claimed design would have been obvious within the meaning of 35 U.S.C. §§103 and 171.*

IV. Conclusion

None of the prior art captures the distinctive visual impression created by Applicants' design in the form of the combination of gently tapered sidewalls, closed corners, a flat rim, and a fine, tight metal mesh.

The prior art cited by the Examiner presents a different overall appearance than the claimed design. The claim construction analysis mandated by *Durling, supra*, demonstrates that elfa drawer depicted in The Container Store® reference is not basically the same as the claimed design, thereby disqualifying the elfa basket from The Container Store® as a *Rosen* reference.

Just as the elfa basket could never be considered “substantially the same” as the claimed design from an infringement standpoint, Gorham v. White, 81 U.S. (14 Wall.) 511 (1871), so too it cannot be “basically the same” as the claimed design from a validity/patentability standpoint, In re Rosen, *supra*.

Finally, the Examiner cannot rely upon obviousness of construction, more appropriate to a utility patent (*see Rosen and Cho, supra*).

REQUEST

Therefore, upon reconsideration in view of the foregoing, this application is believed to be in condition for allowance, and reconsideration thereof with a view towards an early Notice of Allowance is believed in order and is earnestly solicited.

Should the Examiner have any remaining issues that might be resolved with a telephone conversation, he is invited to call Applicants' undersigned counsel at the local number indicated below.

The Commissioner is authorized to charge any fee deficiency, or credit any over payment to Deposit Account No. 19-0031.

"Express Mail" Mailing Label Number: EV 838412060 US.
I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Signature R. Effie Hale
Name R. Effie Hale
Date December 26, 2007

Respectfully submitted,

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Exhibit 1

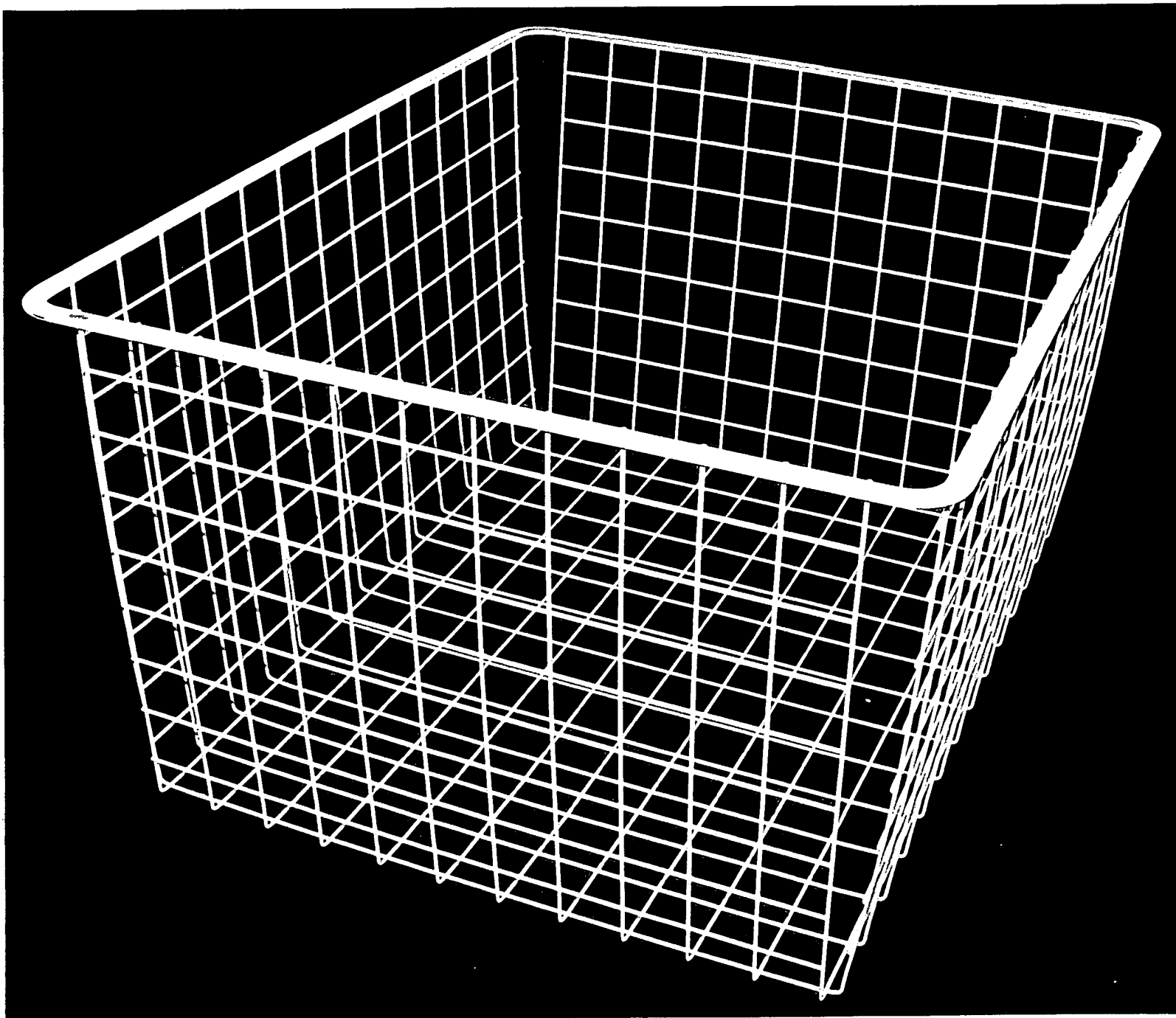


Exhibit 2

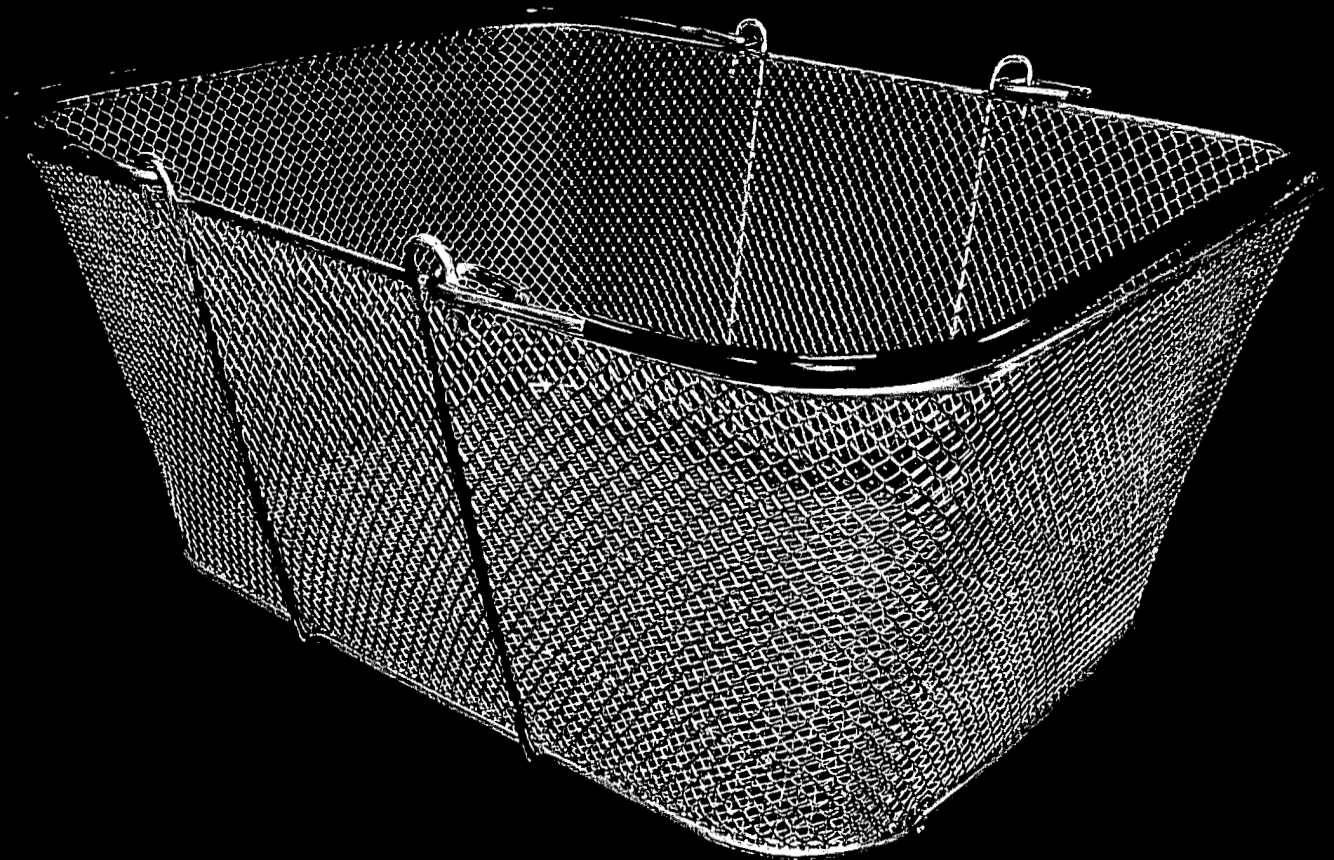


Exhibit 3